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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,526	08/29/2001	Tadahiro Sorori	Q66003	4709

7590 09/08/2003  
SUGHRUE MION ZINN MACPEAK & SEAS PLLC  
2100 Pennsylvania Avenue, NW  
Washington, DC 20037-3213

EXAMINER

GILLIAM, BARBARA LEE

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 09/08/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/940,526

Applicant(s)

SORORI ET AL.

Examiner

Barbara Gilliam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 June 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,6 and 8-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6,15 and 16 is/are allowed.
- 6) ☒ Claim(s) 1,8-14,17 and 18 is/are rejected.
- 7) ☒ Claim(s) 19 and 20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendment filed June 30, 2003 has been fully considered.
2. The 35 USC 112, 2<sup>nd</sup> paragraph rejection of claim 2 is withdrawn.
3. The translation of priority document JP 2000-259525 has been received.
4. The rejections under 35 USC 103 in view of Kodoma et al. (US 6,485,883) as a secondary reference are withdrawn in light of the perfected priority date.
5. Claims 1, 6 and 8-20 are pending.

### ***Information Disclosure Statement***

6. The information disclosure statement filed 8/29/01 & 6/30/03 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. JP 54-135004 has not been considered.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United

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States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

8. Claims 1, 7-14, 17-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Kawamura et al.

a. In US Patent No. 6,132,931, Kawamura et al teach a positive working photosensitive composition comprising a specific fluorine-containing copolymer (abstract). Kawamura et al teach the addition of three types of fluorine-containing copolymers to the positive working photosensitive composition (column 3, lines 20-27). The first fluorine-containing polymer according is a copolymer having at least three components, which are an addition polymerizable monomer having fluoroaliphatic group, an acrylate, methacrylate, acrylamide or methacrylamide and an addition polymerizable monomer (column 3, lines 35-67). The first fluorine-containing copolymer meets the present limitations for the polymer compound having fluoroaliphatic group on the side chain. The fluoroaliphatic group is required to have at least 40 % by weight, preferably 50 % by weight of carbon-bonded fluorine atoms (column 5, lines 23-26). A mixture of monomers, which are different from one another in the chain length of the perfluoroalkyl group present therein, can be used as the fluoroaliphatic group containing monomer. In this formula n can be 6, 8, 10 or 12 (column 6, lines 31-42). This formula of Kawamura et al meets the present limitations for formula (1) and (2) of present claims 8 and 10 respectively. Specifically, the mixture of monomers meets the present limitations for claim 8. The amount of the component derived from the fluoroaliphatic group-containing vinyl monomer in the first fluorine-containing copolymer is generally from 3 to 70% by weight (column 6, lines 43-47). The

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first fluorine-containing copolymer generally has an average molecular weight of from 3,000 to 200,000 and is used in a proportion of 0.001 to 10 % by weight based on the total components of the photosensitive composition (column 33, lines 40-48). The photosensitive composition is coated on the support via solvent and dried (column 55, lines 7-11). The support is a dimensionally stable plate-form material such as aluminum. The support may be subjected to a surface graining treatment for conferring water wettability thereon (column 55, lines 25-55). It is desirable that the graining treatment produces an aluminum plate with a center-line surface roughness (Ra) of from 0.3 to 1.0  $\mu\text{m}$ . The grained aluminum plate is then etched. The solution for the etching treatment is selected from aqueous base or acid solutions such as hydrochloric acid (column 56, lines 35-50). In Examples 1A to 5A, each photosensitive plate was exposed for 1 minute to a 3kW metallic halide lamp and developed with an aqueous solution containing  $\text{SiO}_2$  and  $\text{K}_2\text{O}$  in a ration of 1.16 and having  $\text{SiO}_2$  in concentration of 1.4% (column 62, lines 51-57). The developer comprising a small ratio and low concentration of  $\text{SiO}_2$  meets the present limitations for the developer no substantially containing a silicate.

b. Kawamura et al specifically teach using a conventional method to obtain the first-fluorine containing polymer (column 15, lines 36-39). The first fluorine-containing copolymer meets the present limitations for the polymer compound having fluoroaliphatic group on the side chain wherein the fluoroaliphatic group is produced by a telomerization method or oligomerization method because this claim is a product-by-process claim. Applicant is reminded that determination of patentability is based on the product itself even though the claims are limited by and defined by the process. "If the

product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatenatable even though the product was made by a different process.” MPEP 2113.

### ***Response to Arguments***

9. Applicant's arguments filed June 30, 2003 have been fully considered but they are not persuasive.

a. Applicant argued Kawamura et al. do not teach or suggest the method(s) for making the fluoroaliphatic groups. As pointed out above (and in the previous Office Action), claim 1 is a “product-by-process” claim wherein determination of patentability is based on the product itself even though the claims are limited by and defined by the process. “If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatenatable even though the product was made by a different process.” MPEP 2113. In this instance the products are the same and therefore unpatenatable even though it is not clear what method was used in making the fluoroaliphatic groups of Kawamura et al.

b. Applicant also argued Kawamura et al. do not disclose or suggest the specific ratio of respective monomer units, the preferable alkyl chain length or the effect. As pointed out in the rejection under 35 USC 102(e), the first fluorine-containing copolymer meets the present limitations for the polymer compound having fluoroaliphatic group on the side chain (column 3, lines 35-67 & column 5, lines 23-26). A mixture of monomers, which are different from one another in the chain length of the perfluoroalkyl group present therein, can be used as the fluoroaliphatic group

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containing monomer. This formula of Kawamura et al meets the present limitations for formula (1) and (2) of present claims 8 and 10 respectively. Specifically, the mixture of monomers meets the present limitations for claim 8. (In this formula n can be 6, 8, 10 or 12 (column 6, lines 31-42)). Additionally Applicant is reminded that unexpected results cannot be relied upon to rebut an anticipatory rejection. See MPEP 706.02(b).

***Allowable Subject Matter***

10. Claims 19-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. The following is a statement of reasons for the indication of allowable subject matter:

a. In Examples 1A to 5A, the developer of Kawamura et al. comprises 1.4% SiO<sub>2</sub> which is outside the claimed range.

12. Claims 6, 15-16 are allowed.

13. The following is an examiner's statement of reasons for allowance:

a. With respect to claims 6 and 16, the printing plate of Kawamura et al. (US Patent No. 6,132,931) is positive working meaning there is an increase in developer solubility in exposed areas. The imaging element of Goto (US Patent no. 6,270,940) is laser ablative.



b. With respect to claims 15 and 16, Kawamura et al. do not teach a light-heat converting agent in the photosensitive composition as required in the present application.

c. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Conclusion***

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara Gilliam whose telephone number is 703-305-

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1330. The examiner can normally be reached on Monday through Thursday, 8:00 AM - 5:30 PM.

a. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Baxter can be reached on 703-308-2303. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

b. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

*Barbara Gilliam*

Barbara Gilliam  
Examiner, AU 1752  
September 5, 2003

*RE Ashton*

ROSEMARY ASHTON  
PRIMARY EXAMINER